

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIAKI SHIMADA,
HIDEO OHIRA and KENICHI ASANO

Application No. 09/210,775

ORDER RETURNING TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on April 13, 2004. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith returned to the examiner. The matters requiring attention prior to docketing are identified below.

On November 21, 2003, appellants filed an Appeal Brief (Paper No. 29). According to page 2 of the Examiner's Answer (Paper No. 30), "[t]he copy of the appealed claims contained in the Appendix to the brief is correct." However, it is noted that the language of claims 3 and 4 in the Appendix to the Appeal

Brief differs from its last amended version. Correction is required.

On March 26, 2004, appellants filed a Reply Brief (Paper No. 31) in response to the Examiner's Answer mailed January 29, 2004 (Paper No. 30). On April 4, 2004, an Office communication was mailed (Paper No. 32) which included a rebuttal by the examiner of the position set forth in the Reply Brief.

On December 1, 1997, the rule pertaining to the Examiner's Answer and Reply Brief, 37 CFR § 1.193, was amended to read as follows:

§ 1.193 Examiner's answer and reply brief.

...
(b) (1) Appellant may file a reply brief to an examiner's answer within two months from the date of such examiner's answer. . . . The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

In view of the changes to 37 CFR § 1.193(b)(1), the entry of the examiner's Office communication mailed April 6, 2004 (Paper No. 32) is inappropriate.

Accordingly, it is

ORDERED that the application is returned to the examiner:

1. for issuance of a supplemental Examiner's Answer which contains a corrected copy of claims 3 and 4, or for notification to appellants to submit a new Appendix to the Appeal Brief filed August 11, 2003 (Paper No. 27) which contains the corrected claims;

2. for proper response to the Reply Brief filed March 26, 2004 (Paper No. 31);

3. for written communication to appellants regarding the action taken; and

4. for such further action as may be appropriate.

BOARD OF PATENT APPEALS
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